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08/488,097

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/488,097	06/07/95	LIOTTA	D

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EXAMINER

WONG, K
ART UNIT PAPER NUMBER

1202

13

DATE MAILED: 01/06/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 01/08/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-12, 35 and 36 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-12, 35 and 36 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6 (filed 01/31/97)
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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Detailed Action

1. The amendment filed 01/08/97 is acknowledged. Claims 1-12, 35 and 36 are pending.
2. Claims 3-7, 10, 11 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, the language "in substantially pure form" is vague because it is not defined. How pure is "substantially pure"? At least 95%? 99%? Claims 4-7 are vague because R_1 and R_2 are first defined to be acetic, propionic, butyric or pentanoic, but the claims recite that "and one of R_1 or R_2 can be hydrogen". Does it mean that R_1 and R_2 are acetic, propionic, butyric, pentanoic or hydrogen? Also, the language "acetic, propionic, butyric and pentanoic" is vague because they are not proper names for chemical radicals. Applicants may intend the language to be "acetyl, propionyl, butyryl and pentanoyl". Is that correct? In claims 10 and 11, the term "butyric" is vague because it is not a proper name for a chemical radical. It appears that applicants intend it to be "butyryl".

Claim 36 is vague because, although it is a composition claim, no carrier or excipient was recited.

3. Claims 1-12, 35 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 46-66 of copending Application No. 08/402,730. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the racemates of FTC, FTC derivatives, (+)-enantiomer of FTC, or (+)-enantiomers of FTC derivatives of the instant claims would have been rendered obvious by the (-)-enantiomer of FTC or the (-)-enantiomer of FTC derivatives due to close structural similarity. In light of the teachings of claims 46-66 of '730, one of ordinary skill in the art would have been motivated to make the racemate or (+)-enantiomer in order to obtain additional anti-HIV agents.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-12, 35 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 46-65 of copending Application No. 08/474,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 19 and 46-65 are directed toward the (+)-enantiomer of FTC or its phosphate esters or compositions comprising thereof which would render obvious the subject matters of the instant claims 1-12, 35 and 36.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-12, 35 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-24 and 35-39 of

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copending Application No. 08/482,875. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-24 and 35-39 are directed toward compositions comprising FTC, FTC derivatives or the (+)-enantiomer of FTC or its esters which would render obvious the subject matters of the instant claims 1-12, 35 and 36.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K.L. Wong via telephone at (703) 308-4723 or facsimile at (703) 308-4556 or (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

K.L.W.
January 2, 1998

K. L. Wong
Group 1200